

## **REMARKS/ARGUMENTS**

Claims 1-11 have been cancelled. Claims 12-22 have been withdrawn. Applicant has added new claims 23 -33. For the reasons set forth below, Applicant believes that all pending claims are now in condition for allowance.

### **Examiner's Response to April 28, 2006 Amendment**

The Examiner has withdrawn claims 12-22 that were added by Applicant's April 28, 2006 amendment and response. Because Applicant had cancelled pending claims 1-11, no claims were left to examine. The Examiner has given Applicant one month to correct that omission. The Examiner states:

7. The reply filed on April 28, 2006 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): No claims to examine and the remarks are directed to the newly added claims that have been withdrawn from consideration by Restriction/Election by original presentation. See 37 CFR 1.111. Since the above-referenced reply appears to be *bona fide*, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Applicant has added previously cancelled claims 1 -11 as new claims 23 - 33, with certain amendments as discussed blow. Applicant's remarks below are addressed to the Examiner's rejections of Claims 1 - 11 in the office action mailed December 27, 2005.

### **Examiner's Rejection of Claims 1-11 Under 35 U.S.C. §102 and §103**

The Examiner has rejected claims 1-11 under 35 USC §102 and §103. The Examiner states:

3. Claims 1-8, are rejected under 35 U.S.C. 102(e) as being anticipated by Nicholls et al., (Nicholls) U.S. Patent No. 6,363,414.

4. As to claim 1, Nicholls teaches a method for communicating an online message to a recipient comprising the steps of:

receiving an online communication at an online address corresponding to said recipient (col. 5, line 52 - col. 6, line 16, the user receives an e-mail at his/her e-mail address);

determining an off-line delivery destination corresponding to said online address (col. 8, lines 11-26, if priority has been set for fax, page or telephony then e-mail is forward based on stored delivery destination);

converting said online communication to an appropriate format for off-line delivery (col. 3, lines 37-65, e-mail is converted to fax, pager or telephony format);

delivering said converted online communication to said off-line delivery destination (see Fig. 2a, col. 4, lines 26-40).

5. As to claim 2, Nicholls teaches the method of claim 1 wherein said step of determining an off-line delivery destination comprises the step of receiving said off-line delivery destination from a database (col. 3, line 45-50, col. 3, lines 60-65 and col. 4, lines 5-11).

6. As to claim 3, Nicholls teaches the method of claim 1 wherein said off-line delivery destination comprises a facsimile machine (col. 3, lines 45-50).

7. As to claim 4, Nicholls teaches the method of claim 1 wherein said off-line delivery system comprises a telephone system (col. 4, lines 5-11).

8. As to claim 5, Nicholls teaches the method of claim 3 wherein said step of converting said online communication comprises converting said online communication into a facsimile format (col. 3, lines 37-50).

9. As to claim 6, Nicholls teaches the method of claim 4 wherein said step of converting said online communication comprises converting said online communication into an audio format (col. 3, line 65 - col. 4, line 11).

10. As to claim 7, Nicholls teaches the method of claim 1 wherein said online communication comprises an electronic mail message (see abstract).

11. As to claim 8, Nicholls teaches the method of claim 1 wherein said online address comprises an electronic mail address (see abstract).

\* \* \*

13. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al., (Nicholls) U.S. Patent No. 6,363,414 and in view of Kholer U.S. Patent No. 6,192,396.

14. Nicholls teaches the claimed invention as described above. Nicholls does not explicitly teach grouping of recipients and associating the recipients with a professional group.

Kholer teaches the present invention relates to an authoring system for computerized messages such as electronic mail, and specifically to an authoring system for computerized messages that can create messages containing recipient-specific content among a group of recipients such that all recipients do not receive the identical version of the message. Kholer teaches being able to send a message to the whole group and also recipient-specific messages intended to be seen only by a specific recipient.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the teaching of Kohler into the invention of Nicholls in order to increase the efficiency and reduce the transmission time. Senders are able to transmit a message to a group of recipients, without having to continuously add each recipients name to the TO field.

Applicant respectfully disagrees that claims 23-30 (corresponding to prior claims 1-8) are anticipated by Nicholls and that claim 31-33 (corresponding to prior claims 9-11) are unpatentable over Nicholls in view of Kholer.

New independent claim 23 is equivalent to prior claim 1, with the additional step of "creating an online address for an off-line recipient without knowledge of said recipient." This step is disclosed, for example, on page 25, lines 1-7 of the specification, which state:

For example, in an example of an embodiment of the invention in which the group for which the invention is being implemented is doctors licensed to practice medicine in the United States, e-mail boxes using a consistent naming convention based on the interface server's URL are created for all doctors in the group, regardless of whether or not a doctor has an existing, different e-mail address and without any assistance from or even knowledge of the doctor. (emphasis added).

This limitation of creating an online address for an off-line recipient is not taught or suggested by Nicholls or Kholer. Kholer does not teach or discuss creation of e-mail addresses at all, while Nicholls teaches the normal creation of an e-mail address for a recipient by the recipient selecting the recipient's own e-mail address. Nicholls states:

As is conventional, the first portion of the exemplary e-mail addresses (i.e., nicholls and allport) are termed user identifications, which is typically chosen by the subscriber. Nicholls, col. 2, lines 57-60 (emphasis added).

Accordingly, new independent claim 23 is patentably distinct from Nicholls and Kholer. New dependent claims 24-33 are identical to prior claims 2-11, and contain all of the limitations of independent claim 23 plus additional limitations. Accordingly, dependent claims 24-33 are patentably distinct from Nicholls and Kholer for the same reason as independent claim 23.

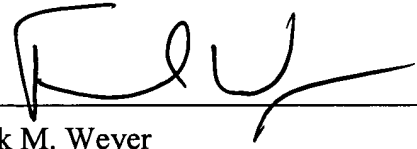
**CONCLUSION**

For the above reasons, Applicant believes that claims 23-33 are in condition for allowance, and respectfully requests that they be allowed.

Respectfully Submitted,

TECHCOASTLAW

Date: 22 August 2006

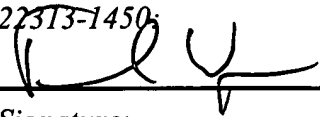
By:   
Frank M. Weyer  
Reg. No. 33,050

TECHCOASTLAW  
264 S La Cienega Blvd  
Suite 1224  
Beverly Hills, California 90211  
(310) 926-3928

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